

Applicant elects the invention of Group II, embodied in Claims 10–27 and 29–71, without traverse.

It is noted for the record that the characterization of each of Groups I and II in the Action employs a shorthand description (“rotigotine”) of the primary active ingredient. In both groups, the primary active ingredient is more correctly rotigotine or a metabolite, prodrug or physiologically acceptable salt thereof.

In relation to the statement in the present Action (p. 3) that U.S. Patent Application Publication No. 2003/0027793 (herein “Lauterbach”) teaches use of rotigotine to treat symptoms of Parkinson’s disease, allegedly including depression, it is further noted for the record that no admission is made herein that Lauterbach (a) constitutes prior art to the present invention or (b) teaches treatment of depression with rotigotine. It is particularly noted that the Lauterbach application is not statutory prior art under 35 U.S.C. §102(b), having published no more than one year before the priority filing date of the present application. Applicant thus reserves the right to disqualify this document as prior art. It is still further noted that, even if Lauterbach does represent prior art, the clinical trial reported therein measured effects of rotigotine only on Parts II and III of the Unified Parkinson’s Disease Rating Scale (UPDRS). Depression is an aspect of behavior and mood and is included in Part I of the UPDRS.

Election of species

The present Action does not contain an express requirement for election of species; however, it does contain verbiage suggesting that the Examiner may have intended to issue such a requirement. If that was indeed the Examiner’s intent, Applicant respectfully traverses the requirement on the ground that the genus of rotigotine or a metabolite, prodrug or physiologically acceptable salt thereof is small enough not to pose an undue search burden on the Office. With such traverse, Applicant provisionally elects rotigotine or a salt thereof as the species for initial examination. The following claims of Group II are readable on the provisionally elected species: Claims 10–20, 23–27, 29–51 and 56–71.

Applicant believes the application is now in condition for examination on the merits. Should any issues remain, the Examiner is invited to call the undersigned at the telephone number given below.

Serial No. 10/565,699
6102-000009/US/NP
Response to Office Action dated March 18, 2009
July 20, 2009

Respectfully submitted,
HARNESS, DICKEY & PIERCE, P.L.C.

A handwritten signature in black ink that reads "James C. Forbes". The signature is written in a cursive, flowing style.

James C. Forbes
Agent for Applicant
Reg. No. 39,457
Tel. 847-412-6350